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REMARKS**I. Introduction**

With the addition of claims 32 to 37, claims ~~2 to 10, 12 to 17, 27, and 31~~ to 37 are currently pending in the present application. It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As an initial matter, Applicants once again respectfully request acknowledgment of the claim for foreign priority and an acknowledgment that the certified copy of the priority application was received in the parent application, i.e., U.S. Patent Application Serial No. 09/971,504.

II. Rejection of Claims 2 to 10, 12 to 17, 27 and 31 Under 35 U.S.C. § 112, 1st ¶

Claims 2 to 10, 12 to 17, 27 and 31 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. While Applicants do not necessarily agree with the merits of the present rejection, claim 10 has been amended herein without prejudice to recite a brake lacquer coating and claims 17 and 31 have been amended herein without prejudice to recite a brake coating. Support for these amendments can be found in the Specification, for example, at p. 3, lines 18 to 32. Applicants respectfully submit that one reasonably skilled in the art of brake coatings could make and use the claimed subject matter based on the description included in the present application coupled with information known in the art without undue experimentation, which is all that is required for compliance with the enablement requirement of the first paragraph of 35 U.S.C. § 112. Accordingly, withdrawal of this rejection is respectfully requested.

III. Rejections of Claims 2 to 10, 12 to 17, 27 and 31 Under 35 U.S.C. § 112, 2nd ¶

Claims 2 to 10, 12 to 17, 27 and 31 were rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. As indicated above, claim 10 has been amended herein without prejudice to recite a brake lacquer coating and claims 17 and 31 have been amended herein without prejudice to recite a brake coating. As such, it is respectfully submitted that the present claims sufficiently set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity, which is all that is required for compliance with the

1194360 6

definiteness requirement of the second paragraph of 35 U.S.C. § 112. Accordingly, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claim 2 to 4, 10, 12 to 14, 17, 27, and 31 Under 35 U.S.C. § 102(b)

Claims 2 to 4, 10, 12 to 14, 17, 27, and 31 were rejected under 35 U.S.C. § 102(b) as anticipated by German Published Patent Application No. 43 14 432 ("DE '432"). Applicants respectfully submit that the present claims are patentable over DE '432 for at least the following reasons.

DE '432 purportedly relates to a corrosion protection agent for organically bonded friction linings. Nowhere does DE '432 disclose, or even suggest, a protective substance having an average grain size that is substantially equal to at least one of a maximum roughness and an average size of score marks of a braking surface of at least one of a brake disk and a brake drum, as required by claim 10, a protective substance having an average grain size substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks of the braking surface of the at least one of the brake disk and the brake drum, as required by claim 17, and a protective substance configured to fill one of a pore and a score of average size on the braking surface of the at least one of the brake disk and the brake drum upon abrading the corrosion protective coating composition by a brake lining during braking, as required by claim 31. DE '432 merely disclose the use of an inorganic zinc compound and, as the Office Action admits, does disclose that the grain size of the inorganic zinc compound is substantially equal to at least one of a maximum roughness, an average pore diameter, and/or an average size of score marks of a braking surface of a brake disk or brake drum to which it may be applied. The abstract of DE '432 is absolutely silent with respect to the grain size of the inorganic zinc compound.

The Office Action seems to allege that it is Applicants' burden to establish that DE '432 does not disclose the grain size recited in claims 10, 17, and 31. Applicants respectfully disagree. In order to establish a prima facie case of anticipation, the Examiner must provide a reference that discloses a protective substance within the recited size range. Providing a reference that discloses an inorganic zinc compound without any information as to the grain size of the inorganic compound does not meet the Examiner's burden.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that DE '432 does not disclose, or even suggest, all of the limitations of claim 10, 17, and 31. Therefore, it is respectfully submitted that DE '432 does not anticipate claims 10, 17, and 31.

"Anticipation under § 102 can be found only when the reference discloses **exactly what is claimed** and that where there are differences between the reference disclosure and the claim, the rejection must be based on § 103 which takes differences into account." Titanium Metals Corp. v. Banner, 778 F.2d 775 (Fed. Cir. 1985) (emphasis added). Further, "[t]o serve as an anticipating reference, the reference must **enable** that which it is asserted to anticipate." Elan Pharms., Inc. v. Mayo Found., 346 F.3d 1051, 1057 (Fed. Cir. 2003) (emphasis added). As indicated above, DE '432 does not disclose the grain size required by claims 10, 17, and 31. Therefore, DE '432 does not disclose **exactly** what is claimed and does not **enable** one skilled in the art to make or use the subject matter as claimed herein.

The silence of DE '432 regarding the grain size of the inorganic zinc compound is not properly interpreted as disclosing every possible grain size. As indicated above, "[a]nticipation under § 102 can be found only when the reference discloses **exactly what is claimed**" and if the prior art **enables one skilled in the art to make or use the subject matter claimed**. Applicants respectfully submit that the disclosure of a friction lining including an inorganic zinc compound in no way constitutes a disclosure of "exactly what is claimed" by claims 10, 17, and 31, which recite a specific grain size for the protective substance, and in no way enables one skilled in the art to make or use the subject matter claimed in claims 10, 17, and 31. It is noted in this regard that the reading of DE '432 as disclosing every possible grain size yields impossible combinations of grain size and coating thickness, for example, combinations in which the layer thickness is smaller than the grain size.

AUG 16 2006

Therefore, the description by DE '432 is not sufficiently specific to anticipate claims 10, 17, and 31, which recite a specific grain size for the protective substance. It is therefore respectfully submitted that DE' 432 does not anticipate claims 10, 17, and 31.

As for claims 2 to 4, and 27, which ultimately depend from claim 10 and therefore include all of the limitations of claim 10, and claims 12 to 14, which depend from claim 17 and therefore include all of the limitations of claim 17, Applicants submit that these claims are patentable over DE '432 for at least the same reasons provided above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**V. Rejection of Claim 2 to 6, 8, 10, 12 to
16, 27, and 31 Under 35 U.S.C. § 102(b)**

Claims 2 to 6, 8, 10, 12 to 16, 27, and 31 were rejected under 35 U.S.C. § 102(b) as anticipated by Russian Published Patent Application Nos. 2169164 ("RU '164") and 2169165 ("RU '165"). Applicants respectfully submit that the present claims are patentable over RU '164 and RU '165 for at least the following reasons.

RU '164 and RU '165 purportedly relate to an anticorrosion paint work compound. Applicants respectfully submit that RU '164 and RU '165 do not disclose, or even suggest, a brake lacquer coating, as recited by claim 10, and a brake coating, as recited by claims 17 and 31. The Office Action admits that RU '164 and RU '165 do not teach that the compound is for braking surfaces. Further, nowhere do RU '164 and RU '165 disclose, or even suggest, a protective substance having an average grain size that is substantially equal to at least one of a maximum roughness and an average size of score marks of a braking surface of at least one of a brake disk and a brake drum, as required by claim 10, a protective substance having an average grain size substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks of the braking surface of the at least one of the brake disk and the brake drum, as required by claim 17, and a protective substance configured to fill one of a pore and a score of average size on the braking surface of the at least one of the brake disk and the brake drum upon abrading the corrosion protective coating composition by a brake

lining during braking, as required by claim 31. Therefore, RU '164 and RU '165 do not anticipate claims 10, 17, and 31.

As for claims 2 to 6, 8, and 27, which ultimately depend from claim 10 and therefore include all of the limitations of claim 10, and claims 12 to 16, which depend from claim 17, Applicants submit that these claims are patentable over RU '164 and RU '165 for at least the same reasons provided above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VI. Rejection of Claim 2, 3, 10, 12, 13,
17, 27, and 31 Under 35 U.S.C. § 102(b)**

Claims 2, 3, 10, 12, 13, 17, 27, and 31 were rejected under 35 U.S.C. § 102(b) as anticipated by European Published Patent Application No. 683,213 ("EP '213"). Applicants respectfully submit that the present claims are patentable over EP '213 for at least the following reasons.

EP '213 purportedly relates to a protective lacquer for a mirror. Applicants respectfully submit that EP '213 does not disclose, or even suggest, a brake lacquer coating, as recited by claim 10, and a brake coating, as recited by claims 17 and 31. The Office Action admits that EP '213 does not disclose a braking coating. Further, nowhere does EP '213 disclose, or even suggest, a protective substance having an average grain size that is substantially equal to at least one of a maximum roughness and an average size of score marks of a braking surface of at least one of a brake disk and a brake drum, as required by claim 10, a protective substance having an average grain size substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks of the braking surface of the at least one of the brake disk and the brake drum, as required by claim 17, and a protective substance configured to fill one of a pore and a score of average size on the braking surface of the at least one of the brake disk and the brake drum upon abrading the corrosion protective coating composition by a brake lining during braking, as required by claim 31. Therefore, EP '213 does not anticipate claims 10, 17, and 31.

As for claims 2, 3, and 27, which ultimately depend from claim 10 and therefore include all of the limitations of claim 10, and claims 12 and 13, which depend from claim 17 and therefore include all of the limitations of claim 17,

Applicants submit that these claims are patentable over EP '213 for at least the same reasons provided above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VII. Rejection of Claim 2 to 6, 8 to 10, 12 to 17, 27, and 31 Under 35 U.S.C. § 102(b)

Claims 2 to 6, 8 to 10, 12 to 17, 27, and 31 were rejected under 35 U.S.C. § 102(b) as anticipated by German Published Patent Application No. 43 41 659 ("DE '659"). Applicants respectfully submit that the present claims are patentable over DE '659 for at least the following reasons.

DE '659 purportedly relates to a protective lacquer for a metal surface coating. Applicants respectfully submit that DE '659 does not disclose, or even suggest, a brake lacquer coating, as recited by claim 10, and a brake coating, as recited by claims 17 and 31. The Office Action admits that DE '659 does not disclose a brake coating. Further, nowhere does DE '659 disclose, or even suggest, a protective substance having an average grain size that is substantially equal to at least one of a maximum roughness and an average size of score marks of a braking surface of at least one of a brake disk and a brake drum, as required by claim 10, a protective substance having an average grain size substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks of the braking surface of the at least one of the brake disk and the brake drum, as required by claim 17, and a protective substance configured to fill one of a pore and a score of average size on the braking surface of the at least one of the brake disk and the brake drum upon abrading the corrosion protective coating composition by a brake lining during braking, as required by claim 31. Therefore, DE '659 does not anticipate claims 10, 17, and 31.

As for claims 2 to 6, 8, 9, and 27, which ultimately depend from claim 10 and therefore include all of the limitations of claim 10, and claims 12 to 17, which depend from claim 17 and therefore include all of the limitations of claim 17, Applicants submit that these claims are patentable over DE '659 for at least the same reasons provided above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VIII. Rejection of Claim 2 to 6, 10, 12 to
17, 27, and 31 Under 35 U.S.C. § 102(b)**

Claims 2 to 6, 10, 12 to 17, 27, and 31 were rejected under 35 U.S.C. § 102(b) as anticipated by German Published Patent Application No. 30 18 765 ("DE '765"). Applicants respectfully submit that the present claims are patentable over DE '765 for at least the following reasons.

DE '765 purportedly relates to a corrosion-protective powdered lacquer film deposition. Applicants respectfully submit that DE '765 does not disclose, or even suggest, a brake lacquer coating, as recited by claim 10, and a brake coating, as recited by claims 17 and 31. The Office Action admits that DE '765 does not disclose a brake coating. Further, nowhere does DE '765 disclose, or even suggest, a protective substance having an average grain size that is substantially equal to at least one of a maximum roughness and an average size of score marks of a braking surface of at least one of a brake disk and a brake drum, as required by claim 10, a protective substance having an average grain size substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks of the braking surface of the at least one of the brake disk and the brake drum, as required by claim 17, and a protective substance configured to fill one of a pore and a score of average size on the braking surface of the at least one of the brake disk and the brake drum upon abrading the corrosion protective coating composition by a brake lining during braking, as required by claim 31. Therefore, DE '765 does not anticipate claims 10, 17, and 31.

As for claims 2 to 6, and 27, which ultimately depend from claim 10 and therefore include all of the limitations of claim 10, and claims 12 to 17, which depend from claim 17 and therefore include all of the limitations of claim 17, Applicants submit that these claims are patentable over DE '765 for at least the same reasons provided above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**IX. Rejection of Claim 2 to 5, 8, 10, 12 to
15, 27, and 31 Under 35 U.S.C. § 102(b)**

Claims 2 to 5, 8, 10, 12 to 15, 27, and 31 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,337,092 ("Hestermann et al."). Applicants respectfully submit that the present claims are patentable over Hestermann et al. for at least the following reasons.

Hestermann et al. purportedly relates to a corrosion-inhibiting pigment and paint composition. Applicants respectfully submit that Hestermann et al. do not disclose, or even suggest, a brake lacquer coating, as recited by claim 10, and a brake coating, as recited by claims 17 and 31. The Office Action admits that Hestermann et al. do not disclose a brake coating. Further, nowhere do Hestermann et al. disclose, or even suggest, a protective substance having an average grain size that is substantially equal to at least one of a maximum roughness and an average size of score marks of a braking surface of at least one of a brake disk and a brake drum, as required by claim 10, a protective substance having an average grain size substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks of the braking surface of the at least one of the brake disk and the brake drum, as required by claim 17, and a protective substance configured to fill one of a pore and a score of average size on the braking surface of the at least one of the brake disk and the brake drum upon abrading the corrosion protective coating composition by a brake lining during braking, as required by claim 31. Therefore, Hestermann et al. do not anticipate claims 10, 17, and 31.

As for claims 2 to 5, 8, and 27, which ultimately depend from claim 10 and therefore include all of the limitations of claim 10, and claims 12 to 15, which depend from claim 17 and therefore include all of the limitations of claim 17, Applicants submit that these claims are patentable over Hestermann et al. for at least the same reasons provided above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

X. Rejection of Claim 2, 3, 8 to 10, 12, 13, 17, 27, and 31 Under 35 U.S.C. § 102(b)

Claims 2, 3, 8 to 10, 12, 13, 17, 27, and 31 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,321,175 ("Schmidt et al."). Applicants respectfully submit that the present claims are patentable over Schmidt et al. for at least the following reasons.

Schmidt et al. purportedly relates to copolymer dispersions. Applicants respectfully submit that Schmidt et al. do not disclose, or even suggest, a brake lacquer coating, as recited by claim 10, and a brake coating, as recited by claims 17 and 31. The Office Action admits that Schmidt et al. do not disclose a brake coating. Further, nowhere do Schmidt et al. disclose, or even suggest, a protective substance

having an average grain size that is substantially equal to at least one of a maximum roughness and an average size of score marks of a braking surface of at least one of a brake disk and a brake drum, as required by claim 10, a protective substance having an average grain size substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks of the braking surface of the at least one of the brake disk and the brake drum, as required by claim 17, and a protective substance configured to fill one of a pore and a score of average size on the braking surface of the at least one of the brake disk and the brake drum upon abrading the corrosion protective coating composition by a brake lining during braking, as required by claim 31. Therefore, Schmidt et al. do not anticipate claims 10, 17, and 31.

As for claims 2, 3, 8, 9, and 27, which ultimately depend from claim 10 and therefore include all of the limitations of claim 10, and claims 12 and 13, which depend from claim 17 and therefore include all of the limitations of claim 17, Applicants submit that these claims are patentable over Schmidt et al. for at least the same reasons provided above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

XI. Rejection of Claim 2 to 7, 12 to 17, 27, and 31 Under 35 U.S.C. § 102(b)

Claims 2 to 7, 12 to 17, 27, and 31 were rejected under 35 U.S.C. § 102(b) as anticipated by European Patent No. 0 976 795 ("EP '795"). Applicants respectfully submit that the present claims are patentable over EP '795 for at least the following reasons.

EP '795 purportedly relates to an antifriction coating for metals and a process for its manufacture. Applicants respectfully submit that EP '795 does not disclose, or even suggest, a protective substance having an average grain size that is substantially equal to at least one of a maximum roughness and an average size of score marks of a braking surface of at least one of a brake disk and a brake drum, as required by claim 10, a protective substance having an average grain size substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks of the braking surface of the at least one of the brake disk and the brake drum, as required by claim 17, and a protective substance configured to fill one of a pore and a score of average size on the braking

surface of the at least one of the brake disk and the brake drum upon abrading the corrosion protective coating composition by a brake lining during braking, as required by claim 31. As detailed above with respect to DE '432, "[t]o serve as an anticipating reference, the reference must enable that which it is asserted to anticipate." Elan Pharms., Inc., 346 F.3d at 1057 (emphasis added). As indicated above, EP '795 does not disclose the protective substance grain size required by claims 10, 17, and 31. Therefore, EP '795 does not disclose exactly what is claimed and does not enable one skilled in the art to make or use the subject matter as claimed herein. Therefore, EP '795 does not anticipate claims 10, 17, and 31.

As for claims 2 to 7, and 27, which ultimately depend from claim 10 and therefore include all of the limitations of claim 10, and claims 12 to 17, which depend from claim 17 and therefore include all of the limitations of claim 17, Applicants submit that these claims are patentable over EP '795 for at least the same reasons provided above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

XII. New Claims 32 to 37

New claims 32 to 37 have been added herein. It is respectfully submitted that claims 32 to 37 add no new matter and are fully supported by the present application, including the Specification. Applicants respectfully submit that new claims are patentable over the reference relied upon for at least the same reasons submitted above in support of the patentability of claims 10, 17, and 31.

XIII. Conclusion

Applicants respectfully submit that all of the pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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